

## DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name; I believe that I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled "OPTO-ELECTRICAL DEVICES," the specification of which was filed on August 13, 2001, as Application Serial No. 09/913,380 and was amended on August 13, 2001. I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment(s) referred to above. I acknowledge the duty to disclose to the Patent and Trademark Office all information known to me to be material to patentability as defined in 37 C.F.R. §1.56.

I hereby claim foreign priority benefits under 35 U.S.C. §119 of any foreign application(s) for patent or inventor's certificate or of any PCT international application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) of which priority is claimed:

Priority Claimed

9903251.8	Great Britain	12 February 1999	<input checked="" type="checkbox"/>	<input type="checkbox"/>
(Application Serial Number)	(Country)	(Day/Month/Year Filed)	Yes	No

I hereby claim the benefit under 35 U.S.C. §119(e) of any United States provisional application(s) listed below:

_____	_____
(Application Serial Number)	(Day/Month/Year Filed)

I hereby claim the benefit under 35 U.S.C. §120 of any United States application(s) or PCT international application(s) designating the United States of America listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior application(s) in the manner provided by the first paragraph of 35 U.S.C. §112, I acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in 37 C.F.R. §1.56 which occurred between the filing date of the prior application(s) and the national or PCT international filing date of this application:

PCT/GB00/00478	14 February 2000	Pending
(Application Serial Number)	(Day/Month/Year Filed)	(Status-Patented, Pending or Abandoned)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

POWER OF ATTORNEY: I hereby appoint as my attorneys, with full powers of substitution and revocation, to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:

John B. Lungmus (18,566)  
 Allen H. Gerstein (22,218)  
 Nate F. Scarpelli (22,320)  
 Michael F. Borun (25,447)  
 Carl E. Moore, Jr. (26,487)  
 Richard H. Anderson (26,526)


Patrick D. Ertel (26,877)  
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 James P. Zeller (28,491)  
 Kevin D. Hogg (31,839)  
 Jeffrey S. Sharp (31,879)  
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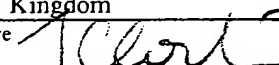
James J. Napoli (32,361)  
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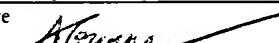
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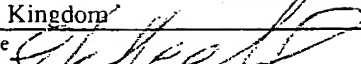
Send correspondence to: James P. Zeller

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Fifth Joint Inventor, if any Ian S. Millard	Citizenship Great Britain
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State or Country United Kingdom	State or Country United Kingdom
Date <input checked="" type="checkbox"/>	Signature

## APPLICABLE RULES AND STATUTES

### 37 CFR 1.56. DUTY OF DISCLOSURE - INFORMATION MATERIAL TO PATENTABILITY (Applicable Portion)

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is canceled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is canceled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentability defines, to make sure that any material information contained therein is disclosed to the Office.

Information relating to the following factual situations enumerated in 35 USC 102 and 103 may be considered material under 37 CFR 1.56(a).

### 35 U.S.C. 102. CONDITIONS FOR PATENTABILITY: NOVELTY AND LOSS OF RIGHT TO PATENT

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
- (c) he has abandoned the invention, or
- (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraph (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent, or
- (f) he did not himself invent the subject matter sought to be patented, or
- (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

### 35 U.S.C. 103. CONDITIONS FOR PATENTABILITY; NON-OBVIOUS SUBJECT MATTER (Applicable Portion)

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

### 35 U.S.C. 112. SPECIFICATION (Applicable Portion)

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.



**MAY 22 2002**  
UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT  
UNITED STATES PATENT AND TRADEMARK OFFICE  
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MAY 30 2002

MARSHALL GERSTEIN

In re Application of  
BURROUGHES, Jeremy H., et al.  
Application No.: 09/913,380  
PCT No.: PCT/GB00/00478  
Int. Filing Date: 14 February 2000  
Priority Date: 12 February 1999  
Attorney Docket No.: 29610/CDT087B  
For: OPTO-ELECTRICAL DEVICES

DECISION ON  
PETITION UNDER  
37 CFR 1.47(a)

This is a decision on applicants' "Renewed Petition Under 37 C.F.R. §1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 29 April 2002.

#### BACKGROUND

On 14 February 2000, applicants filed international application PCT/GB00/00478, which claimed a priority date of 12 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 17 August 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 11 September 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 13 August 2001 (12 April 2001 was a Sunday).

On 13 August 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and an English translation of the international application.

On 19 September 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required. The NOTIFICATION set a two-month extendable period for reply.

On 19 December 2001, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a petition for a one-month extension of time; the fee for a one-month extension of time; a declaration of inventorship executed by Jeremy H. Burroughes, Julian C. Carter, Alec G. Gunner, and Stephen K. Heeks; a statement of facts from Ann Brown; and copies of letters, emails and file notes.

On 01 March 2002, the Office mailed Decision On Petition Under 37 CFR 1.47(a) dismissing applicants' petition without prejudice.

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On 29 April 2002, applicants filed "Renewed Petition Under 37 C.F.R. §1.47(a)," accompanied by, *inter alia*, the Federal Express tracking history of a package delivered on 19 November 2001.

### DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant

Items (1), (3) and (4) were previously met.

Item (2) has now been met. Applicants have provided the tracking history for the package delivered to the US work address of Mr. Millard. The package included a copy of the full application papers.

### CONCLUSION


For the above reasons, applicants' petition under 37 CFR 1.47(a) is GRANTED.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

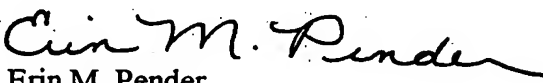
As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including accordation of a 35 U.S.C. date of 19 December 2001.



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